



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yukinobu MOMOZONO et al.

Group Art Unit: 2628

Application No.: 10/648,368

Examiner: J. WANG

Filed: August 27, 2003

Docket No.: 116609

For: FONT PROCESSOR, TERMINAL DEVICE, FONT PROCESSING METHOD, AND
FONT PROCESSING PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is attached. Applicants respectfully request review of the Final Rejection mailed May 31, 2007 regarding the above-identified application in light of the following remarks. Claim 12 is pending in this application and is rejected. This review is requested for the following reasons.

I. The Pending Claim Recites Statutory Subject Matter

The Office Action rejects claim 12 under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Office Action asserts that claim 12 recites subject matter that is non-statutory computer software *per se*. Under MPEP § 2106.01, computer programs claimed as computer listings *per se*, i.e., the descriptions or expression of the programs, are not physical "things" and are neither computer components nor statutory process (MPEP § 2106.01). Claim 12, however, clearly recites a font processor, comprising a data acquiring device, a subpixel-font

generating device and a target character pixel expansion unit. The combination of at least these features cannot reasonably be considered to be limited to computer listings per se. As such, this rejection is improper.

II. The Pending Claim Complies with the Enablement Requirement

The Office Action rejects claim 12 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

The Office Action, on pages 8-14, asserts that the specification would not enable one of ordinary skill in the art to practice the subject matter recited in claim 12. Specifically, the Office Action asserts that the subject matter recited in claim 12 is inconsistent with the specification because the third and fourth determination units recited in claim 12 allegedly omit essential components that provide the basis for shifting the target pixel. These assertions are incorrect for at least the following reasons.

MPEP §2164.01, quoting *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), states "the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." This standard is clearly met with regard to Applicants' disclosure and the features recited in claim 12.

With reference to paragraphs [0044] and [0046] and Fig. 5, patterns 3a, 3b, 4a and 4b, of Applicants' specification, the Office Action asserts that the third and fourth determination units "should" recite certain other features. The Office Action, however, (1) fails to read the plain meaning of claim 12, and (2) apparently attempts to impose on Applicants the burden of showing enablement of features not recited in claim 12.

Applicants indicate that analysis is performed on a selected target pixel and that Figs. 4 and 5 illustrate exemplary pattern examples (paragraphs [0040] and [0042]). With respect to the target pixel, CPU 16 determines whether the eight surrounding pixels are in a

configuration, exemplified by patterns 1a or 1b, 2, 3a or 3b, and 4a or 4b as shown in Figs. 4 and 5 (paragraphs [0042]-[0048]). Applicants further disclose a logic that CPU 16 applies to the target pixel based on these determinations (Claim 12, paragraphs [0042] – [0048]).

Based on Applicants' disclosure, as briefly discussed above, and the features recited in claim 12, it is unreasonable to assert that claim 12 need recite any further or modified features other than what claim 12 plainly recites. Further, as Applicants' disclosure adequately supports the features recited in claim 12, it is unreasonable to assert that claim 12 does not comply with the enablement requirement.

III. Specific Features Recited in the Pending Claims are Not Taught by the Applied Reference

The Office Action, on page 2, rejects claim 12 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. US 2003/0020729 A1 to Toji et al. (hereinafter "Toji"). This rejection is respectfully traversed.

The Office Action asserts, on page 2, that Toji teaches a display method with features that are alleged to correspond to the combinations of all of the features recited in claim 12. This assertion is incorrect for at least the following reasons.

MPEP §2131.01 states "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added) *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Toji teaches comparing 3 x 3 pixel configurations around a target cell (bitmap patterns) with a library of 256 possible 3 x 3, or 8-pixel, configurations (reference patterns) (see paragraphs [0181]-[0182]). Toji, however, does not teach a subpixel-font generating device that separately analyzes character pixel configuration of the font data using pattern matching to generate subpixel fonts, the subpixel fonts being data in units of subpixels as

recited in claim 12. Toji also does not teach the subpixel-font generating device includes a first determination unit, a second determination unit, a third determination unit, a fourth determination unit and a target character pixel expansion unit, or a logic for the application of each determination unit to the target pixel, as recited in claim 12.

For example, Toji does not disclose separately analyzing a target cell. For each bitmap pattern, Toji references the library in order to match that bitmap pattern with its appropriate reference pattern in the library. Based on an accurate match, Toji assigns sub-pixel combinations to the target cell. Although this process is repeated for each target cell, it is unreasonable to assert that the disclosure of Toji analyzes each pixel separately. The target cell in Toji merely labels the bitmap pattern. Toji's analysis is limited to matching 8-pixel patterns and not individual target pixels.

As another example, Toji does not disclose the determination units and systematic operating steps effectuated by the subject matter recited in claim 12. Toji, in contrast, teaches a pattern-determining unit and a pattern-correcting unit for making the bitmap/reference comparisons and assigning sub-pixel patterns (see paragraphs [0037]-[0039]). These patterning units, however, are limited to comparing and assigning patterns and do not even suggest the logic of the determination units recited in claim 12. Toji, then, does not teach the determination units, the corresponding logic or the combination of these features recited in claim 12.

Further, contrary to the Office Action's subjective assessment that Toji's method is "superior" to the subject matter recited in claim 12 because it allegedly reduces aliasing, the shortfalls of Toji discussed above limit the capacity of Toji to efficiently execute a target cell analysis by eliminating steps according to the quality of adjacent cells. The Office Action's subjective preference for Toji in this regard is clearly irrelevant to the determination of

whether Toji explicitly teaches recited claim features. As discussed above, Toji clearly does not teach at least the above-quoted and above-referenced features recited in claim 12.

IV. Conclusion

In summary, claim 12 recites statutory subject matter, is adequately enabled by the disclosure, and is not taught by the applied reference.

In view of the foregoing, Applicants respectfully request that the Review Panel review the substance of the May 31 Final Rejection in light of the above remarks. Applicants believe that upon such review, the Review Panel will determine that the Office Action's formal rejections of claim 12 are improper and that Toji does not anticipate the subject matter recited in claim 12. In this regard, favorable reconsideration and prompt allowance of claim 12 are earnestly solicited.

Should the Review Panel believe that anything further would be desirable in order to place this application in an even better condition for allowance, the Review Panel is invited to contact Applicants' undersigned representative.

Respectfully submitted,



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JAO:CJW/clf

Attachment:
Notice of Appeal

Date: July 31, 2007

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